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EXAMINER

STERRETT, JONATHAN G

| ART UNIT | PAPER NUMBER |
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3623

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/823,421

Applicant(s)

CONNELLY, JAY H.

Examiner

Jonathan G. Sterrett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/29/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Summary

1. Claims 1-27 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites "A system comprising a machine readable medium and a processor, the machine readable medium having instructions which when executed by the processor cause the system to perform operations comprising: ". It is not clear whether an apparatus or an article of manufacture is claimed. A processor is claimed, which indicates the claim to be of an apparatus. However, the rest of the claim seems to describe software, which indicates an article of manufacture.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13 are rejected under 35 U.S.C. 101 because the invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts: and

(2) whether the invention produces a useful, concrete and tangible result.

6. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, none of the claims are directed to anything in the technological arts as explained above. Looking at the claims as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer performs the recited steps. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides a method for obtaining customer feedback to a product provider; which is a useful, concrete and tangible result. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, Claims 1-13 are directed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country; more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace US 5,848,396.

Regarding Claim 1, Gerace discloses:

receiving a request to obtain consumer feedback (column 12 line 59-60, sponsors of advertisements can obtain reports through requesting them);

sending at least one product description data to a plurality of clients (column 12 line 7-10, ad package object comprises product description data; column 8 line 13-16, ads are displayed on webpages of a plurality of clients);

receiving a feedback data from each of the plurality of clients transparent to the user of the clients (column 12 line 57-63, computer subroutine, transparent to user, records successful use of advertisements, including hits and click-throughs);

processing a consumer feedback summary based on the feedback data (column 13 line 9-11, Demographic Response Rate Report for advertisements).

Regarding Claim 2, Gerace discloses:

communicating the consumer feedback summary to a product provider (column 18 line 51-53, sponsor request for report causes reporting subroutine to communicate the report back to the sponsor)

Regarding Claim 3, Gerace discloses wherein the request to obtain consumer feedback is received from a product provider (column 12 line 7-9, sponsors have ad packages which can be for products, services or any other information found in advertisements).

Regarding Claim 10, Gerace discloses wherein the request to obtain consumer feedback comprises a request to compare the success of two or more ways of marketing a product (column 19 line 48-50, sponsor can create a customized report to follow success of advertisement; column 19 line 66-column 20 line 6, program 31 allows sponsors to compare success rates of different advertisements and advertising aspects).

Regarding Claim 11, Gerace discloses wherein the consumer feedback summary comprises a marketing success comparison data (column 19 line 66-column 20 line 6, program 31 allows sponsors to compare success rates of different advertisements and advertising aspects).

Regarding Claim 12, Gerace discloses wherein the product description data comprises meta-data (column 12 line 28-32, profile information in ad series object comprises metadata).

Regarding Claim 13, Gerace discloses the product description data comprises program guide information (column 22 line 43-52, media and TV schedule information comprises program guide information).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace US 5,991,735 in view of Abelow US 5,999,908.

Regarding Claim 4, Gerace teaches obtaining customer feedback transparent to the user regarding advertisements. Gerace doesn't teach wherein the request to obtain consumer feedback comprises a request to test the success of one or more products. Abelow does teach wherein the request to obtain consumer feedback comprises a request to test the success of one or more products (column 9 line 38-39, module obtains findings during the course of product uses; column 19 line 54-56, automatic findings from field trials for product uses; column 33 line 3; module can obtain data from passive interactions, where the user is unaware that data is being gathered on their use of product; column 38 line 61-67, product performance may be passively gathered without the customer's involvement; column 18 line 24-26, customer feedback addresses success of product while in use). Abelow teaches that providing feedback while a product is in use is of strategic competitive advantage since it enables vendors to immediately understand a customers likes/dislikes arising from use of a product (column 18 line 33-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gerace, as discussed above, with the request to obtain consumer feedback comprises a request to test the success of one or more products, as taught by Abelow, because it would provide strategic advantage to vendors of products by providing immediate feedback from customers while a product was being used.

Regarding Claim 5, Gerace teaches obtaining advertisement success data regarding how advertisements were viewed (column 13 line 11-12, ad success data used in regression). Gerace does not teach wherein the consumer feedback summary comprises a product success data for each of the one or more products. Abelow teaches wherein the consumer feedback summary comprises a product success data for each of the one or more products (column 18 line 67 – column 19 line 3, vendors can apply module to all of the products in a particular market to obtain feedback regarding success and failure of product in that market to better tailor products for that market; column 25 line 20-23, digital data capturing customer interactions is transmitted back to vendor's computer; column 55 line 15-19, reports of customer feedback quantitative information is presented in a way that is easily understood). Abelow teaches that providing feedback while a product is in use is of strategic competitive advantage since it enables vendors to immediately understand a customer's likes/dislikes of a product (column 18 line 33-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gerace, as discussed above, with the request to obtain consumer feedback comprises a product success data for each of the one or more products, as taught by Abelow, because it would provide strategic advantage to vendors of products by providing immediate feedback from customers while products were being used.

Regarding Claim 6, Gerace teaches obtaining advertisement success data regarding how advertisements were viewed (column 13 line 11-12, ad success data used in regression). Gerace does not teach wherein the request to obtain consumer

feedback comprises a request to compare the success of two or more attributes of a product. Abelow teaches wherein the request to obtain consumer feedback comprises a request to compare the success of two or more attributes of a product (column 38 line 17-12, data gathered on features that customers use). Abelow teaches that providing feedback while a product is in use is of strategic competitive advantage since it enables vendors to immediately understand a customers likes/dislikes of a product (column 18 line 33-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gerace, as discussed above, with wherein the request to obtain consumer feedback comprises a request to compare the success of two or more attributes of a product, as taught by Abelow, because it would provide strategic advantage to vendors of products by providing immediate feedback from customers while products were being used.

Regarding Claim 7, Gerace teaches obtaining advertisement success data regarding how advertisements were viewed (column 13 line 11-12, ad success data used in regression). Gerace does not teach wherein the consumer feedback summary comprises an attribute success comparison data. Abelow teaches wherein the consumer feedback summary comprises an attribute success comparison data (column 42 line 33-35, benchmarking probes capture data what the customers like about the product while using it, including that of various attributes of the product; column 55 line 30-36, various reports are available including graphs which provide ability to compare the success data). Abelow teaches that providing feedback while a product is in use is of strategic competitive advantage since it enables vendors to immediately understand

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a customers likes/dislikes of a product (column 18 line 33-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gerace, as discussed above, with wherein the consumer feedback summary comprises an attribute success comparison data, as taught by Abelow, because it would provide strategic advantage to vendors of products by providing immediate feedback from customers while products were being used, where the feedback provided ability to compare the success of various attributes of the product.

Regarding Claim 8, Gerace teaches obtaining advertisement success data regarding how advertisements were viewed (column 13 line 11-12, ad success data used in regression). Gerace does not teach wherein the request to obtain consumer feedback comprises a request to compare the success of two or more products.

Abelow teaches wherein the request to obtain consumer feedback comprises a request to compare the success of two or more products (column 42 line 20-24, benchmark probes solicit customer feedback regarding competing products). Abelow teaches that providing feedback while a product is in use is of strategic competitive advantage since it enables vendors to immediately understand a customers likes/dislikes of a product (column 18 line 33-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gerace, as discussed above, with wherein the request to obtain consumer feedback comprises a request to compare the success of two or more products, as taught by Abelow, because it would provide strategic advantage to vendors of products by providing immediate feedback from

customers while products were being used, where the feedback provides the ability to understand the success of two or more products in the marketplace.

Regarding Claim 9, Gerace teaches obtaining advertisement success data regarding how advertisements were viewed (column 13 line 11-12, ad success data used in regression). Gerace does not teach wherein the consumer feedback summary comprises a product success comparison data. Abelow teaches wherein the consumer feedback summary comprises a product success comparison data (column 9 line 38-39, module obtains findings in the middle of product uses; column 19 line 54-56, automate findings from field trials for product uses; column 33 line 3; module can obtain data from passive interactions, where the user is unaware that data is being gathered on them; column 38 line 61-67, product performance may be passively gathered without the customer's involvement; column 18 line 24-26, customer feedback addresses success of product while in use; column 55 line 15-29, customer based product design reports presents quantitative information in a way that is easily understood by the customer, including graphs and charts where comparisons can easily be made). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gerace, as discussed above, with wherein the consumer feedback summary comprises a product success comparison data, as taught by Abelow, because it would provide strategic advantage to vendors of products by providing immediate feedback from customers while products were being used, where the feedback provides the ability to compare the success of a product in the marketplace.

Claims 14-27 recite limitations handled by the rejections of Claims 1-13 above, therefore the same rejection applies.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

BusinessWire, "MessageMedia Launches SupportView", November, 1999.

Foremski, Tom, New digital technology is putting more choice in the hands of traditional TV audiences who will increasingly be able to decide their own programme schedules, March 3, 1999, Financial Times, Surveys, p17.

US 6,513,014 by Walker discloses a method for administering a survey via a television transmission network.

US 5,991,735 by Gerace discloses an apparatus for determining the behavioral profile of a computer user.

US 5,227,874 by Von Kohorn discloses method for measuring the effectiveness of stimuli on decisions of shoppers.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 703-305-0550. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 2-10-2005



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